

## REMARKS

Claims 1, 13-16, 18, 20, 22, 23, 30, 31, 33-36, 44-48, 51, 55-79, and 82-84 are pending in the application. Claims 1, 13-16, 18, 20, 22, 23, 30, 31, 33-36, 44-48, 51, 55-79, and 82-84 stand rejected under 35 U.S.C. 103(a).

### Claim Amendments

The foregoing amendment clarifies the expression of the invention. Support for the amendment is found throughout the specification and in the original claims as detailed below. Accordingly, no new matter has been added. New claim 85 focuses on features of Applicant's method and system for bill payment services, such as establishing both a common payee list and a customer-specific payee list and allowing customers to designate payees from either one. Further, a customer can designate a payee from the customer-specific payee list by simply entering an ID for the payee, or if the customer does not have the payee's ID handy, the customer can select the payee by having the customer-specific payee list spoken by the bill payment application. Alternatively, the customer can select the payee by having the common payee list spoken by the bill payment application. In addition, conditions are established for non-optionally handing off the customer to a customer service representative for non-automated verification of the customer's identification as a security measure, if the customer selects either the recurring bill payment or change payee options.

### Claim Rejections - 35 USC § 103

Claims 1, 13-16, 18, 20, 22, 23, 30, 31, 33-36, 44-48, 51, and 55-79 stand rejected over Transue et al. in view of Lawlor et al. and in further view of Porter et al. Presumably, claims 82-84 stand rejected over Transue et al. in view of Lawlor et al. and Porter et al., as well. The rejection is respectfully traversed and reconsideration is requested. Transue et al., Lawlor et al., and Porter et al. do not teach or suggest the claimed invention either separately or in combination with one another.

The invention involves a system and method for automated bill payment in which customer identification information is received and verified by the retail system application and handed off to the bill payment application. (See page 11, line 9-page line 9). In response to a prompt by the bill payment application, a customer selection is received for a touch tone or a voice mode of communication. (See page 14, line 18-page 15, line 16). In response to further prompts, a customer selection of one of a number of bill payment options is received by the bill payment application, such as a recurring bill payment option, an add or change

payee for bill payment option, a single bill payment option, and a status, change or cancel bill payment option. (See page 15, line 17-page 16, line 2). If the customer selects either the recurring bill payment option or the add or change payee for bill payment option, the bill payment application automatically, non-optionally hands off the customer to a customer service representative at a telephone for a non-automated verification of the customer's identification as a security measure. (See page 30, line 24-page 31, line 26).

In response to further prompts, the bill payment application receives a customer selection of an option to designate a payee from either a customer-specific payee identification list or a common payee list provided by the bill payment application. If the customer elects to designate the payee from the customer-specific list, in response to additional prompts, the bill payment application receives a customer selection of the payee by either entering a payee ID, or if the customer does not have the payee ID at hand, by having the customer-specific payee identification list spoken by the bill payment application. (See page 16, line 25-page 21, line 2). In response to still further prompts, the bill payment application receives information regarding a payment amount (See page 21, line 14-page 22, line 4) and a payment date (See page 22, line 5-page 23, line 3) and automatically schedules the bill payment. Thereafter, the bill payment application prompts the customer for and receives confirmation of the payee, the payment amount, and the payment date and renders the scheduled payment to the payee by check or electronic transfer of funds on the scheduled payment date. (See page 32, line 8-page 33, line 14).

Specifically, independent method claim 1 and corresponding system claim 75 propose a system and method for automated bill payment in which customer identification information is received and verified by the retail system application, and the customer is handed off with the customer identification to the bill payment application. The customer then selects either a touch tone or a voice mode of communication and any of a number of bill payment options, such as a recurring bill payment option, an add or change payee for bill payment option, a single bill payment option, and a status, change or cancel bill payment option. If the customer selects either the recurring bill payment or the add or change payee for bill payment options, the bill payment application automatically, non-optionally hands off the customer to a customer service representative for a non-automated verification of the customer's identification as a security measure. The customer is able to designate a payee from either the customer-specific payee list or the common payee list, and a customer who chooses the customer-specific list is further

able to select the payee by either entering a payee ID or by having the customer-specific payee list spoken by the bill payment application. Upon receiving the payee designation, a payment amount, and a payment date, the bill payment application schedules the bill payment, prompts and receives confirmation from the customer, and renders the scheduled payment to the payee by check or electronic transfer of funds on the scheduled payment date.

Claims 13-16 depending on claim 1 propose that the bill payment information is received in the voice mode, or alternatively, in the touch tone mode. Claims 18, 20, 22, and 23 depending on claim 1 propose that the customer selects at least one of the recurring bill payment option, the add or change a payee for option, the single bill payment option, or the status, change or cancel bill payment option. Claims 30, 31, and 33-36 depending on claim 1 propose that the bill payment application identifies the payee by either the payee ID entered by the customer, the customer's selection from the spoken customer-specific payee list, or the customer's selection from the spoken common payee list. Claims 44-48 depending on claim 1 propose that the bill payment application assigns and furnishes a payment reference and summarizes the scheduled bill payment for the customer and speaks scheduled bill payments for the customer if requested. Claim 51 depending on claim 1 proposes that the scheduled bill payment is combined in a check with one or more other bill payments. Claims 55-62 depending on claim 1 propose prompting and receiving the customer's selection of the status of either future bill payments, all open bill payments, or all bill payments for the customer and speaking the selected status by the bill payments application for the customer. Claims 63-66 depending on claim 1 propose prompting and receiving the customer's selection of either the single bill payment or change of a future bill payment for the customer. Claims 67-74 propose prompting and receiving the customer's selection of either the recurring bill payment or cancellation of a future bill payment option and handing off the customer to a customer service representative for non-automated verification of the customer's identification.

Independent method claim 82 proposes a method of bill payment service in which conditions are established for non-optionally handing off the customer to a customer service representative for a non-automated verification of the customer's identification as a security measure, if the customer selects, for example, either the recurring bill payment option or the add or change payee for bill payment option. The customer is allowed to enter a selection from the menu, and if one of the conditions for hand-off is received, the bill payment application non-optionally hands the customer off to the customer service representative for

non-automated verification. Independent method claim 83 proposes a method of bill payment service in which both a common payee list and a customer-specific payee list are established on the bill payment application, and the customer is prompted and allowed to select the payee for bill payment from either list. Independent claim 84 proposes a method of bill payment service in which the condition for non-optionally handing off the customer to the customer service representative for non-automated verification of the customer's identification is invoked if the customer selects, for example, the recurring bill payment option or the change payee option, and the customer is also allowed to select a payee from either the customer-specific payee list or the common payee list.

New claim 85 proposes a method of bill payment service, in which conditions for non-optionally handing off the customer to a customer service representative for non-automated verification of the customer's identification are invoked, if the customer selects either the recurring bill payment or change payee options. Further, the customer can elect to designate the payee by entering a payee ID from the customer-specific payee list, or if the customer does not have the payee's ID handy, by having the customer-specific payee list spoken by the bill payment application. Alternatively, the customer can designate the payee from the common payee list spoken by the bill payment application.

In contrast, Transue et al. (U.S. Pat. No. 5,893,902) describe a system for bill payment by telephone that requires users to audibly pre-record a list of billers and later select billers by speaking their names using voice recognition technology, and the system confirms the selection by playing back the name of the selected biller to the user. (Transue et al., Col. 3, lines 2-14). Users who dial up the system are offered options to make, review, change or cancel a payment, change or add to the biller list, hear a description of the service, speak to a CSR, change a password, and presented additional menus, depending on the selection. (Transue et al., Col. 3, line 66-Col. 4, line 20). Users who select a one-time or recurring bill payment are prompted to speak the biller's name, which the system compares to the user's pre-recorded list and plays back to the user for confirmation. If confirmed, the bill is scheduled for payment. (Transue et al., Col. 11, line 32-Col. 13, line 65). Users are connected to a CSR by selecting the option to speak to a CSR. (Transue et al., Col. 6, lines 17-21).

Thus, Transue et al. do not recite the required combination proposing, for example, that the customer is non-optionally handed off to a customer service representative for non-automated verification of the customer's identification if the customer selects either

the recurring bill payment or change payee options or that the customer can elect to designate the payee from the customer-specific payee list in response by entering a payee ID or by having the customer-specific payee list spoken by the bill payment application or alternatively by having the common payee list spoken by the bill payment application.

Lawlor et al. (U.S. Pat. No. 5,220,501) fails to cure the deficiencies of Transue et al. Lawlor et al. describe an ATM system for paying multiple bills (Lawlor et al., Col. 6, lines 30-36) using a central computer to send electronic funds transfer requests to the user's bank via the ATM network and distribute the funds to billers requested by the user. (Lawlor et al., Col. 7, lines 5-24). Users are required to provide a pre-specified biller list in advance (Lawlor et al., Col. 42, line 60-Col. 43, line 24), which can include anyone without limitation (Lawlor et al., Col. 10, lines 44-53). Users enter a selection from the pre-specified biller list and an amount, and a confirmation message is displayed. (Lawlor et al., Col. 33, lines 3-22). Users can pay current or future bills (Lawlor et al., Col. 44, line 1-Col. 45, line 11) or schedule periodic bill payments (Lawlor et al., Col. 45, lines 12-20). Payments are made electronically either immediately or "warehoused" for transmittal with other payments to the same biller or paid by check. (Lawlor et al., Col. 11, lines 55-60).

Consequently, Transue et al. in view of Lawlor et al. do not recite the required combination proposing, for example, that the customer is non-optionally handed off to a customer service representative for non-automated verification of the customer's identification if the customer selects either the recurring bill payment or change payee options or that the customer can elect to designate the payee from the customer-specific payee list in response by entering a payee ID or by having the customer-specific payee list spoken by the bill payment application or alternatively by having the common payee list spoken by the bill payment application.

Porter et al. (U.S. No. 5,825,856) fail to cure the deficiencies of Transue et al. and Lawlor et al. Porter et al. describe an interactive voice response system bill payment system. (Porter et al., Col. 3, lines 13-18). The bill payment menu includes options to make, cancel, or change a payment, get payment information, add or remove a payee, or set up a recurring payment. (Porter et al., Col. 20, line 54-Col. 21, line 10). Users select billers by dialing or speaking numbers corresponding to the first letters of biller names from a system list (Porter et al., Col. 22, lines 25-54 and Fig. 17A) and confirming the biller name or trying another selection if the first selection is not found in the system list. (Porter et al., Col. 23, lines 44-60) Users are connected to a CSR by selecting the option

to speak to a CSR (Porter et al., Col. 5, lines 35-45), allowing a timeout to expire (Porter et al., Col. 5, lines 47-63), entering disabled or invalid identification numbers (Porter et al., Col. 7, lines 1-15), or multiple unsuccessful attempts to enter a selection (Porter et al., Col. 8, lines 13-19).

Consequently, Transue et al. in view of Lawlor et al. and Porter et al. do not recite the required combination proposing, for example, that the customer is non-optionally handed off to a customer service representative for non-automated verification of the customer's identification if the customer selects either the recurring bill payment or change payee options or that the customer can elect to designate the payee from the customer-specific payee list in response by entering a payee ID or by having the customer-specific payee list spoken by the bill payment application or alternatively by having the common payee list spoken by the bill payment application.

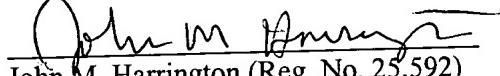
Because the cited references, either alone or in combination, do not teach the limitations of independent claims 1, 75, or 82-85, the Examiner has failed to establish the required *prima facie* case of unpatentability. See In re Royka, 490 F.2d 981, 985 (C.C.P.A., 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); See also MPEP §2143.03. Similarly, the Examiner has failed to establish a *prima facie* case of unpatentability for claims 13-16, 18, 20, 22, 23, 30, 31, 33-36, 44-48, 51, 55-74 that depend on claim 1 or claims 76-79 that depend on claim 75.

**Conclusion**

In view of the foregoing amendment and these remarks, each of the claims remaining in the application is in condition for immediate allowance. Accordingly, the examiner is requested to reconsider and withdraw the rejection and to pass the application to issue. The examiner is respectfully invited to telephone the undersigned at (336) 607-7318 to discuss any questions relating to the application.

Respectfully submitted,

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